

REMARKS

Reconsideration and withdrawal of the rejections of the claims is respectfully requested. Prior to the present amendments, claims 1-30 were pending. By way of the above amendment, claims 31-48 have been added. Accordingly, claims 1-48 currently are pending.

The November 18, 2004 Office Action is Incomplete

Before proceeding with an analysis of the pending rejections, it is to be noted that in response to the first Office Action dated July 15, 2004, Applicant submitted an Amendment on September 16, 2004, in which new claims 21-30 were added. However, the November 18, 2004 final Office Action dated neither considers nor acknowledges claims 21-30. Therefore, the final Office Action is incomplete. Applicant respectfully requests that the Examiner fully consider the present amendments and remarks.

The Naoi et al. Patent Fails to Anticipate All Claimed Features

In the most recent Office Action, the Examiner maintained the rejection of claims 1, 10, 11 and 20 under 35 U.S.C. §102, as allegedly being anticipated by the Naoi et al. patent (U.S. Patent No. 6,721,463). In section 5 beginning on page 2, the Action states that the arguments presented in Applicant's response of September 15, 2004, were not considered persuasive. More particularly, the Action asserts that one of the features of claim 1 that Applicant relied on in his arguments, namely "a judgment unit that judges whether the character images should be converted to character code data ... depending on at least one of the character recognition certainties of said character images contained in the character image group," is described in column 21, lines 48-52 of the Naoi et al. patent. Applicant respectfully disagrees and submits that the Naoi et al. patent fails to describe this feature in combination with the other features of claim 1, and similar distinctions set forth in claim 11.

On page 3, lines 16-17 of the final Office Action, the Examiner asserts that claims 1 and 11 do not preclude storing character codes as well as image data. It is respectfully submitted, however, that this assertion by the Examiner does not relate

to the combinations of features set forth in independent claims 1 and 11, which include a judgment unit that judges, and a step of judging whether character images *should be converted to character code data*. Furthermore, it does not relate to the claimed feature of judging whether all character images contained in a specific character image group formed as an assembly of multiple adjoining character images *should be prohibited* from being converted into character code data depending on at least one of the character recognition certainties of said character images contained in the character image group, as recited in claims 1 and 11. In contrast, the parts Naoi et al. relied upon appear to infer, at best, that a judgment is made whether or not the image data of a character string *should be stored along with character code of the string*.

Moreover, Applicant submits that the Examiner's statement, "[A]ll characters in the character string are prohibited from being converted to a character code and are stored as [an] image of the character string ... " (page 3, lines 6-8), and similar statements on page 3 directed to the breadth of the claims, neither address the claimed judgment operation of claim 1 nor the claimed process of judging recited in claim 11. For instance, claim 1 specifies, among other claimed features, that a judgment unit prohibits all character images contained in a specific character image group constituted as an assembly of multiple adjoining character images from being converted into character code data. This prohibiting action is executed based on at least one of the character recognition certainties of said character images contained in the character image group. Independent claim 11 recites similar distinctions. By contrast, Naoi et al. disclose generating character codes without exception (column 21, lines 29-30, 50-51 and 54-55). More particularly, Naoi et al. describes a judgment that results in either character code being stored as management information, or both character code and the image data being stored as management information.

The Examiner also states, "[C]laims 1 and 11 use the transitional phrase "comprising" which does not preclude the reference from having additional features besides the claimed features." However, the fact that the language "comprising" does not, hypothetically, preclude reading a claim on a reference that describes things in addition to features recited in the claim does not substitute for factual

evidence that must be present in the Naoi et al. patent to support the disclosure of, either by explicit, implicit or inherent description, the judgment operation and judgment process respectively set forth in independent claims 1 and 11.

Additionally, with regard to inherency under Section 102, the description in Naoi et al. of storing image data when a determination of low reliability is made does not *necessarily* mean that a judgment is made as to whether that image data *should be converted to character code data*, much less whether it should be prohibited from being converted to character code, as claimed. In clear contradistinction, the Naoi et al. apparatus operates to *always* convert each character of a character string into character code upon user selection of a character recognition mode (see, column 21, lines 29-55). This is done by Naoi et al., to provide more than one way to store/retrieve management information in the particular situation of “low reliability” character code data, which allows for more user flexibility to select from among modes when storing/retrieving management information (see, column 22, lines 12-19). However, these benefits described in the Naoi et al. patent provide no hint or implication of judging whether character images *should be converted to character code data* as claimed.

Furthermore, when considering the method of computing the reliability of character recognition described in lines 33-47 of column 21 of Naoi et al., a person of skill of ordinary skill in the art would understand that “reliability of character recognition” is generated *for each character*. When considering this understanding with the parts of Naoi et al. relied upon in the Action (i.e., column 21, lines 48-52 and Figure 26), a person of ordinary skill in the art would understand that a judgment in Naoi et al. is made whether or not to store image data along with character data based on the reliability of character recognition *for each character*. Hence, Naoi et al. does not disclose that “all character images contained in a specific character image group constituted as an assembly of multiple adjoining character images are prohibited from being converted into character code data based on at least one of the character recognition certainties of said character images contained in the character image group,” and thus also does not disclose the claimed judgment unit recited in claim 1, and similar distinctions set forth in claim 11.

For at least these reasons, claims 1 and 11 are considered patentable.

Claims 10 and 20 are considered allowable, if for no other reason than these claims depend from one of independent claims 1 and 11, and further for the additional features recited.

The Action also maintained the rejection of claims 9 and 19 as allegedly being obvious over the Naoi et al. in view of the Seto Toshio document. Claims 9 and 19 respectively depend from one of independent claims 1 and 11. Hence, claims 9 and 19 are allowable for at least the above reasons. Furthermore, it is respectfully submitted that the Seto Toshio document fails to remedy the shortcomings pointed out above with respect to independent claims 1 and 11. As such, claims 9 and 19 are considered patentable.

Claims 21-30 are believed allowable based on the absence of any objections or rejections pertaining to these claims in the Office Action. New claims 31-48 also are believed patentable.

For the foregoing reasons, it is respectfully submitted that the rejections of claims 1-20 should be withdrawn and the application passed to issue without further delay. Prompt notification of the same is earnestly solicited.

Respectfully submitted,

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Date: February 15, 2005

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